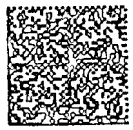
BOX

Alexandria, VA 22313-1450
If Undeliverable Return in Ten Days

OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, $300

AN EQUAL OPPORTUNITY EMPLOYER



UNITED STATES POSTAGE
PRIORITY MAIL
02 1M $ 01.82⁰
0004244975 JAN 25 2008
MAILED FROM ZIP CODE 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,371	10/02/2001	Noel Tenorio	020431.0917	1757

53184 7590 01/25/2008
i2 TECHNOLOGIES US, INC.
ONE i2 PLACE, 11701 LUNA ROAD
DALLAS, TX 75234

EXAMINER	
CHANDLER, SARA M	
ART UNIT	**PAPER NUMBER**
3693	

MAIL DATE	DELIVERY MODE
01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/970,371	TENORIO, NOEL	
	Examiner	Art Unit	
	SARA CHANDLER	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-15,17-24 and 26-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 8-15, 17-24, 26-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for continued examination of application 09/970,371 (10/02/01) filed on 10/30/07.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

> Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
>
> Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP § 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "*for* _____"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "*for* _____"), but does not result in a

structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

> USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.
>
> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:
>
> (A) statements of intended use or field of use,
> (B) "adapted to" or "adapted for" clauses,
> (C) "wherein" clauses, or
> (D) "whereby" clauses.
>
> See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Information Disclosure Statement

The information disclosure statement filed 11/28/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, copies of the NPL references O and U on the IDS are missing.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 8-15, 17-24, 26-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble of claims 1,10,19,28 and 29 would suggest that they fall within one of the four enumerated statutory classes listed above. Clams 1 and 29 directed to system claims, claim 10 directed to a method, and claim 18 directed to software embodied on computer readable medium. The claims however within the category of a judicial exceptions (i.e., law of nature, natural phenomenon, abstract idea) and there is no practical application of the judicial exception (i.e., physical transformation; useful, concrete and tangible result).

The claimed invention does not pertain to a "physical transformation" to a different state or thing. The claimed invention does not provide a "useful, concrete and tangible result" because it cannot be relied on to make a decision. For example, there is no trigger, threshold etc. that one might observe to recognize some real world result. In fact a result is not provided by the claimed invention at all. Thus, any result achieved is not tangible because it is abstract and fails to provide a real world result. The displays are presented to the users and are prone to their subjective interpretations. Thus, any result achieved is not concrete because it is not predictable or repeatable. In other words, any arbitrary result could be achieved depending the subjective viewpoint of the user.

The process involves presentation of data via arrangement of images (bars charts etc.). As such this claim fails to achieve a "practical application" because the arrangement of the images (regardless of what the images represent) do not serve any functionality. It is asserted that such ornamental displays cannot be relied upon to patentably distinguish an invention since no structural element (or process function) dependant on the arrangement of the graphical images. *In re In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) as quoted in MPEP 2144.04. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). See also MPEP § 2106.01, II regarding Nonfunctional Descriptive Material.

The display of information via user information, in the instant case is related to the precedents dealing with printed matter – i.e., the presentation of information in a

form that is useful and intelligible only to human mind. *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). ("The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." Id. at 1386.). Here there is no unobvious functional relationship between the graphical display and the information appearing thereon. The functional relationship, in contradiction, between the arrangement of the information and the mind of user- i.e. to reinforce an idea in the user's mind. See also MPEP § 2106.01, II regarding Nonfunctional Descriptive Material.

Thus, the language is the claims are interpreted as not further limiting because it presents actions that are to be undertaken by a user, yet whether the user undertakes these actions is optional and thus there is no guarantee that the user will do it.

Thus, the language is the claims are interpreted as not further limiting because it represents nonfunctional descriptive material.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-15, 17-24, 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,10,19, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, steps and/or structural cooperative relationships of elements, such omission amounting to a gap between the elements, steps and/or the necessary structural connections. See MPEP § 2172.01. The omitted elements are: elements, steps and/or structural cooperative relationships of elements.

The preamble of claims 1 and 29 suggests that the claims are drawn an electronic marketplace computer system. A system claim is defined by its structural components. Claims 1 and 29 only identify one structural component (i.e., the market server) and fail to provide for additional structural components required to carry out the claimed invention.

How do you access the user request (i.e., from a database, internet etc.)? Note the claimed system has no other structural components.

Re Claims 1,10 19,28 and 29: The claim recites "electronic marketplace" What is this? Please define. This term is broad and subject many interpretation. Can this be any online environment?

Re Claims 1,10 19,28 and 29: The claims recite "a plurality of entered values for a plurality of offer variables." Should this be -- a plurality of entered values for a plurality of offer variables --. Are these the same "values" and "offer variables" referred to previously in the claim? If so, should "the" or "said" and consistent terminology should be used. If not, how are they different?

Re Claims 1,10,19 and 28: The term "substantial" is a relative term which renders the claims indefinite. The term is not defined by the claim, the specification

does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Re Claim 29: The terms "readily visually distinguishable" and "substantially similar" are relative terms which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Re Claim 29: The claim contains features or limitations that fails to correlate with those recited in claims 1,10,19 and 28: Is this intentional?

Dependent claims are rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3,5-9,10-12,14-18, 19-21, 23-27,28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal, US Pat. No. US Pub. No. 2002/0032637.

Re Claims 1-3,5-7,10-12,14-16 19-21, 23-25 and 28: Moshal discloses an electronic marketplace computer system/method/software embodied in computer-readable media for providing visualization of market offers, the system comprising:

market server operable to (Moshal, [0006] [0044] [0045] [0046]):

means for/ receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]);

means for/ access a user request, the user request comprising a plurality of entered values for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]);

means for/ generate a display (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)) comprising:

a user request display comprising one or more patterns representing the user request, the one or more patterns for the user request comprising a plurality of geometric display elements, each geometric display element representing a particular offer variable and comprising a set of one or more geometric display elements of a different type that by

virtue of their appearance collectively encode, according to a predefined encoding scheme, an entered value for the offer variable corresponding to the bar (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)); and

an offers display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of geometric display elements, each geometric display element representing a particular offer variable and comprising a set of one or more geometric display elements of a different type that by virtue of their appearance collectively encode, according to the a predefined encoding scheme, a value for the offer variable corresponding to the bar, the user request display and the offers display are visibly comparable for determining a substantial match between at least one of the plurality of patterns representing a particular offer and the one or more patterns representing the user request (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)):.

Moshal fails to explicitly disclose:

a user request display comprising one or more patterns representing the user request, the one or more patterns for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a

predefined encoding scheme, an entered value for the offer variable corresponding to the bar; and

an offers display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the a predefined encoding scheme, a value for the offer variable corresponding to the ~ bar, the user request display and the offers display are visibly comparable for determining a substantial match between at least one of the plurality of patterns representing a particular offer and the one or more patterns representing the user request.

Examiner Note: Thus, the only difference between Moshal and the claimed invention is that the pattern comprises: a plurality of bars, each bar representing a particular offer variable.

In light of Moshal, the claimed invention would have been obvious based on any one of the following rationales:

Official Notice

Official Notice is taken that it was old and well-known at the time of the invention to provide:

a user request display comprising one or more patterns representing the user request, the one or more patterns for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric

display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, an entered value for the offer variable corresponding to the bar; and

an offers display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the a predefined encoding scheme, a value for the offer variable corresponding to the ~ bar, the user request display and the offers display are visibly comparable for determining a substantial match between at least one of the plurality of patterns representing a particular offer and the one or more patterns representing the user request.

Examiner notes, that the display represents a user interface. It was old and well-known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

Documentary Evidence:

"Microsoft Press Computer Dictionary Third Edition," editor: Kim Fryer. Copyright 1997 by Microsoft Corporation. Pg. 488;

Pearson Education. Copyright 2001 by Addison-Wesley. Pg. 11; and

Free On-line Dictionary of Computing. Copyright 1993-2007 Denis Howe.

Examiner further notes, that it was old and well-known at the time of the invention to manipulate the presentation of the information in a variety of ways in accordance with the preferences of a particular user. These presentations included the use of patterns

incorporating bars, columns, grids etc. For example, Excel programs have been used frequently in reports, slide shows and presentations to show diagrams in the form of bars, lines and other visual forms.

Documentary Evidence:

"Mastering Excel 4 For Windows," by Carl Townsend. Copyright 1992 by Sybex. Chapter 20, pgs. 423-454.;

Levine, US Pub. No. 2002/0178105 - Fig. 6 ;

Lee, US Pub. No. 2002/0065762 - Figs. 5-14; [0030] [0056]; and

Russell, US Pat. No. 7,020,630 - Fig. 8

See also MPEP § 2144.03.

Design Choice

Design choice is a ***conclusion*** reached by the Examiner regarding the difference between the claims and the prior art. This conclusion is based on a two prong test involving an analysis of ***the totality of the record*** including applicants own specification, and an analysis of whether the prior art would ***perform equally as well*** as the claimed subject matter.

A rejection based on design choice does not require that a reference expressly or even impliedly teach the difference between the claims and the prior art.

Applicant provides the following in the Specification:

> Business transactions are increasingly taking place over the Internet and other electronic communication networks. Electronic markets may provide a forum for such transactions, allowing buyers to locate sellers, and vice versa. This process may involve a buyer (or seller) identifying one or more suitable offers to sell (or buy) from one or more sellers (or buyers). **However, it may be difficult for a buyer (or seller) to identify suitable offers to sell (or buy) from among the**

> **offers available to the buyer (or seller) for a number of reasons.** For example, there may be a relatively large amount of information for a buyer (or seller) to consider when trying to identify suitable offers to sell. The market may include a relatively large number of offers. Offers may include a number of variables, and there may be a relatively large number of possible values for each variable. **Additionally, there may be no available offers providing a substantial match with a particular order from the buyer (or seller). The buyer (or seller) may therefore have to determine which of the available offers provide a relatively close match with that order, taking into account a number of offer variables and possibly the relative priorities of such variables.**

Applicant' Specification, pg. 2 (10/02/01).

What is not made apparent from the record however, is how the particular visual patterns of the claimed invention resolves any problem, provides any advantage or is used for any purpose above and beyond what the visual patterns of the prior art can do equally well.

The visual patterns of Moshal perform equally well at identifying suitable offers to sell (or buy) for the offers available to the buyer (or seller); and enabling the buyer (or seller) to discern which offers prove the closest match to a particular order. That is, factors such as whether it is a offer, user request or order is distinguished; the price; the size; whether a user is a buyer or seller, the length of time a user has been in the marketplace; whether orders and offers are close to a match or consummating a transaction etc. are readily apparent from the visual pattern of Moshal. See Moshal, abstract, Figs. 1-18; [0001] – [0047]).

Examiner notes, whether presented as circles, bars, stars or any other visual pattern, the same problem could be resolved, the same advantage achieved, and

purpose addressed. The fact that Applicant provides a pattern comprising a plurality of bars, each bar representing a particular offer variable is not the basis for a patentability determination. If that were the case, an infinite number of patents could be issued representing the offer and the offer variables as lines, or arrows or any other symbol and none would be any less obvious in light of Moshal.

See also *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

Nonfunctional Descriptive Material

> Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106.01.

Examiner notes, " a user request display comprising one or more patterns representing the user request, the one or more patterns *for* the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements *that by virtue of their appearance* collectively encode, according to a predefined encoding scheme, an entered value for the offer variable corresponding to the bar; and

an offers display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements *that by virtue of their appearance* collectively encode, according to the predefined encoding scheme, a value for the offer variable corresponding to the bar, the user request display and the offers display *are visibly comparable* for determining a

substantial match between at least one of the plurality of patterns representing a particular offer and the one or more patterns representing the user request."

Thus, the language is the claims are interpreted as not further limiting because it presents actions that are to be undertaken by a user, yet whether the user undertakes these actions is optional and thus there is no guarantee that the user will do it. See also discussion supra under § 101.

The limitations are interpreted as a compilation or mere arrangement of data. The visual pattern of the data does not provide a functional interrelationship, and is considered to be non-functional descriptive material and is not further limiting of the claimed invention. See also *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). See also discussion supra under § 101.

Thus, based on any of the above rationales, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal to provide a an electronic marketplace computer system/method/software embodied in computer-readable media for providing visualization of market offers further comprising: a user request display comprising one or more patterns representing the user request, the one or more patterns for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, an entered value for the offer variable corresponding to the bar; and an offers display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer

and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the a predefined encoding scheme, a value for the offer variable corresponding to the ~ bar, the user request display and the offers display are visibly comparable for determining a substantial match between at least one of the plurality of patterns representing a particular offer and the one or more patterns representing the user request.

As suggested by Moshal, users should have access to an easily understandable version of the current state of critical data and any objects other than circles could be used to represent the buyers and sellers (and inherently, there respective offers also). (Moshal, abstract, [0003] [0006] [0027]).

Re Claims 8,17 and 26: Moshal discloses system/method/software, wherein the market server is further operable to:

receive a selection of a particular pattern associated with a particular offer (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features);

receive an instruction to generate an order based on the values for the offer associated with the selected pattern (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features);

in response to receiving the instruction, automatically generate an order based

on the values for the offer associated with the selected pattern (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features); and

communicate the generated order for matching with the selected offer (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features).

Re Claims 9, 18 and 27: Moshal discloses a system/method/software, wherein the market server is further operable to display the values specified in the user request and the values specified in the offer associated with the selected pattern (Moshal, Figs. 1-18; [0006] [0024] [0026] [0027] [0028] [0029] [0030] [0031] [0032] [0033] [0034] [0035] [0038] [0039] [0040] [0044] [0045] Inherent features).

Re Claim 29: Moshal discloses an electronic marketplace computer system for providing visualization of market offers, the system comprising:

a market server operable to (Moshal, [0006] [0044] [0045] [0046]):

receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and

access a user request, the user request comprising a plurality of entered values for a plurality of offer variables (Moshal, abstract, [0006] [0025] [0026] [0027] [0040] [0042] [0044] [0045]); and

generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and particular offer variables and

comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, values for the offer variables, the predefined encoding scheme being selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] plurality offers (e.g., bid/ask, seller/buyer), plurality of offer variables (e.g., #items, type, user, price, length of participation etc.)); and

generate within the display a pattern representing the user request, the pattern for the user request comprising particular offer variables and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined scheme, entered values for the offer variables, such that a user may compare the pattern for the user request with the patterns for one or more offers in connection with a market decision (Moshal, Figs. 1-18; [0006] [0024] [0025] [0026] [0027] [0029] [0030] [0031] [0033] [0034] [0035] [0039] [0040] [0041] [0044] [0045] (e.g., bid/ask, seller/buyer).

Moshal fails to explicitly disclose:

generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars,

each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar.

Examiner Note: Thus, the only difference between Moshal and the claimed invention is that the pattern comprises: a plurality of bars, each bar representing a particular offer variable.

In light of Moshal, the claimed invention would have been obvious based on any one of the following rationales:

Official Notice

Official Notice is taken that it was old and well-known at the time of the invention to "generate a display of the received offer data, the display comprising a plurality of

patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar."

Examiner notes, that the display represents a user interface. It was old and well-known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

Documentary Evidence:

"Microsoft Press Computer Dictionary Third Edition," editor: Kim Fryer. Copyright 1997 by Microsoft Corporation. Pg. 488;

Pearson Education. Copyright 2001 by Addison-Wesley. Pg. 11; and

Free On-line Dictionary of Computing. Copyright 1993-2007 Denis Howe.

Examiner further notes, that it was old and well-known at the time of the invention to manipulate the presentation of the information in a variety of ways in accordance with the preferences of a particular user. These presentations included the use of patterns incorporating bars, columns, grids etc. For example, Excel programs have been used frequently in reports, slide shows and presentations to show diagrams in the form of bars, lines and other visual forms.

Documentary Evidence:

"Mastering Excel 4 For Windows," by Carl Townsend. Copyright 1992 by Sybex. Chapter 20, pgs. 423-454.;

Levine, US Pub. No. 2002/0178105 - Fig. 6 ;

Lee, US Pub. No. 2002/0065762 - Figs. 5-14; [0030] [0056]; and

Russell, US Pat. No. 7,020,630 - Fig. 8

See also MPEP § 2144.03.

Design Choice

Design choice is a ***conclusion*** reached by the Examiner regarding the difference between the claims and the prior art. This conclusion is based on a two prong test involving an analysis of ***the totality of the record*** including applicants own specification, and an analysis of whether the prior art would ***perform equally as well*** as the claimed subject matter.

A rejection based on design choice does not require that a reference expressly or even impliedly teach the difference between the claims and the prior art.

Applicant provides the following in the Specification:

> Business transactions are increasingly taking place over the Internet and other electronic communication networks. Electronic markets may provide a forum for such transactions, allowing buyers to locate sellers, and vice versa. This process may involve a buyer (or seller) identifying one or more suitable offers to sell (or buy) from one or more sellers (or buyers). **However, it may be difficult for a buyer (or seller) to identify suitable offers to sell (or buy) from among the offers available to the buyer (or seller) for a number of reasons.** For example, there may be a relatively large amount of information for a buyer (or seller) to consider when trying to identify suitable offers to sell. The market may include a relatively large number of offers. Offers may include a number of variables, and there may be a relatively large number of possible values for each variable. **Additionally, there may be no available offers providing a substantial match with a particular order from the buyer (or seller). The buyer (or seller) may therefore have to determine which of the available offers provide a relatively close match with that order, taking into account a number of offer variables and possibly the relative priorities of such variables.**

Applicant' Specification, pg. 2 (10/02/01).

What is not made apparent from the record however, is how the particular visual patterns of the claimed invention resolves any problem, provides any advantage or is used for any purpose above and beyond what the visual patterns of the prior art can do equally well.

The visual patterns of Moshal perform equally well at identifying suitable offers to sell (or buy) for the offers available to the buyer (or seller); and enabling the buyer (or seller) to discern which offers prove the closest match to a particular order. That is, factors such as whether it is a offer, user request or order is distinguished; the price; the size; whether a user is a buyer or seller, the length of time a user has been in the marketplace; whether orders and offers are close to a match or consummating a

transaction etc. are readily apparent from the visual pattern of Moshal. See Moshal, abstract, Figs. 1-18; [0001] – [0047]).

Examiner notes, whether presented as circles, bars, stars or any other visual pattern, the same problem could be resolved, the same advantage achieved, and purpose addressed. The fact that Applicant provides a pattern comprising a plurality of bars, each bar representing a particular offer variable is not the basis for a patentability determination. If that were the case, an infinite number of patents could be issued representing the offer and the offer variables as lines, or arrows or any other symbol and none would be any less obvious in light of Moshal.

See also *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975)

Nonfunctional Descriptive Material

> Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP § 2106.01.

Examiner notes that " generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually

distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar."

Thus, the language is the claim is interpreted as not further limiting because it presents actions that are to be undertaken by a user, yet whether the user undertakes these actions is optional and thus there is no guarantee that the user will do it. See also discussion supra under § 101.

Thus the language in the claim is interpreted as a compilation or mere arrangement of data. The visual pattern of the data does not provide a functional interrelationship, and is considered to be non-functional descriptive material and is not further limiting of the claimed invention. See also *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). See also discussion supra under § 101.

Thus, based on any of the above rationales, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal to provide an electronic marketplace computer system for providing visualization of market offers, the system comprising:

generate a display of the received offer data, the display comprising a plurality of patterns, each pattern representing a particular offer and comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to a predefined encoding scheme, a value for the offer variable corresponding to the bar, the predefined encoding scheme is selected such that a set of geometric display elements encoding a first value of a first offer variable in a first pattern associated with a first offer are readily visually distinguishable from a set of geometric display elements encoding a second value of the first offer variable in a second pattern associated with a second offer if the first value is not substantially similar to the second value; and

generate within the display a pattern representing the user request, the pattern for the user request comprising a plurality of bars, each bar representing a particular offer variable and comprising a set of one or more geometric display elements that by virtue of their appearance collectively encode, according to the predefined encoding scheme, an entered value for the offer variable corresponding to the bar.

As suggested by Moshal, users should have access to an easily understandable version of a the current state of critical data and any objects other than objects other than circles could be used to represent the buyers and sellers (and inherently, there respective offers also). (Moshal, abstract, [0003] [0006] [0027]).

Claims 4,13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal as applied to claims 1,10 and 19 above, and further in view of Reamer, US Pub. No. 2002/0194104.

Re Claims 4,13 and 22: Moshal fails to explicitly disclose system/method/software, wherein a user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL). Official Notice is taken that it is old and well-known for buyers and sellers to limit their business transactions to preferred parties. Specifically, it was old and well known to provide wherein a user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL). For example, preferred lists are used in auctions, shopping, online transactions etc. (Reamer, abstract; [0016] [0018] [0021]; claims 2,3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Moshal by adopting the teachings of Reamer to provide system/method/software, wherein the user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL).

One would have been motivated to avoid fraud, maintain business related and facilitate a more efficient experience.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

The premise of the rejection given is drawn to two concepts:

The claims are to be given their broadest reasonable interpretation and thus not all language in the claims are entitled to patentable weight. See discussion supra. See MPEP § 2111, 2106.; and

The claimed invention is obvious in light of Moshal because the rationales of Official Notice, Design Choice and Nonfunctional descriptive material. See discussion supra. Documentary evidence of the Official Notice taken is on the record, and corresponding bibliographic information can be found supra and in prior Office Actions.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As discussed supra the knowledge generally available to one of ordinary skill in the art was such that the claimed invention would have been obvious in light of Moshal. See discussion supra.

Furthermore, as suggested by Moshal, users would have been motivated to have access to an easily understandable version of a the current state of critical data and any objects other than circles could be used to represent the buyers and sellers (and inherently, there respective requests/offers also). (Moshal, abstract, [0003] [0006] [0027]). Examiner notes, that Moshal provides that there is a need to provide data

pertaining to an electronic marketplace in a format that is easy to understand. Thus, Moshal provides for the representation of the various players in the marketplace (i.e., buyers/sellers) and the attributes of their requests/offers in visual pattern. Moshal goes on to suggest that visual patterns other than those disclosed in Moshal could also be used to represent the buyers/sellers (and inherently their respective requests/offers also).

Please note also that recent court decision provide that rationale other that TSM (teaching, suggestion, motivation may be used) in obviousness rejection.

> The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set forth in Graham v. John Deere Co. (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. KSR, 550 U.S. at _ , 82 USPQ2d at 1391. See MPEP § 2141.

The claimed invention is also obvious under the rationales:

(C) Use of known technique to improve similar devices (methods, or products) in the same way.

See discussion supra under official notice, design choice.

(D) Applying a known technique to improve a known device (method, or product) ready for improvement to yield predictable results.

See discussion supra under official notice, design choice.

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art.

See discussion supra under design choice.

See MPEP § 2143.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

JAGDISH N. PATEL
PRIMARY EXAMINER